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EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/673,050	Applicant(s) COURSON ET AL.	
	Examiner Janice A. Mooneyham	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on June 21, 2006, wherein claims 1-12 are currently pending.

Response to Amendment

Claim Objections

2. The applicant states that claim 8 is an independent claim. Thus, the Examiner removes the objection.

Drawings

3. The replacement drawings of Figure 2 received on June 21, 2006 are acceptable.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on June 21, 2006 is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

For example, in claim 1, the applicant claims a discovery mechanism to combine discovery related information and form discovery materials to produce discovery items for use in litigation. The specification fails to provide an adequate written description of the invention so that one of skill in the art could practice the claimed invention without undue experimentation. The specification does not describe how to combine stored discovery related information and form discovery materials to produce discovery items, what mechanisms are used to make such combination, or how the data or what data is merged in such a way as to enable one skilled in the art to make or use the invention.

The specification states as follows:

[0009] The tool provides counsel with a data collection mechanism. This mechanism guides counsel through various steps in the litigation process and directs counsel and/or legal assistants to determine what information is required to reach the stated goals. For example, the tool provides a "Discovery Generator" that is available to capture counsel's potential discovery requests, which are normally thought of during the process of reviewing documents and then forgotten or lost. ***These potential discovery requests are captured and stored. Later, when discovery requests are called for, the tool provides links to existing document and form production tools for facilitated production of discovery,*** such as Interrogatories or Requests for Production. Links to these document and form production tools are available at various steps in the use of the tool.

[0053] One of the important phases of a lawsuit is the discovery process. It is often long and complicated and used to gather much of the evidence and facts present for the particular case. It is common to have sample or form discovery materials available, particularly when the law firm is relatively experienced in a given area. However, in each particular case there are particular individualized discovery questions or relevant information which must be gained. Further, it is often common that these particular individualized questions are only developed as the evidence is being reviewed by the attorney and/or paralegal. To remember this particular question which has been developed during this document review, the person jots it down on a piece of paper or a note which is stuck on their monitor. Then during the course of the lawsuit the notes are lost or they fall off the monitor and are swept away.

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Thus this highly transitory and relevant information is lost and discovery is somewhat hampered. Review of FIGS. 99 and 100 illustrates that the tool includes a method of gathering and maintaining these particular transitory discovery questions. It is noted in the upper right-hand corner of the exemplary screen shots that there is a button indicated "Discovery Generator." Clicking on Discovery Generator brings up a drop down box shown in FIG. 100. The class or category of discovery is indicated, an entry is made to whom the particular discovery is directed and then the ultimate question is entered. This question is then saved into a collection as shown on FIG. 99.

[0054] Also shown on FIG. 99 are a series of buttons and drop downs to generate the particular discovery materials. For example, buttons are shown for interrogatories, requests for production, requests for admissions, client requests and attorney notes. For deposition questions, witness questions, and agency requests, because these would all be directed to particular parties, selection boxes are provided to determine which are the desired parties for the desired discovery. When the selection is made or the button is clicked, the particular materials are generated. ***The tool selects the particular discovery questions shown in FIG. 99 and merges them with other form discovery materials relating to the particular type. When this is done, each related output is developed,*** generally with suitable word processing tools. Secretaries and assistants could fine-tune the particular documents as necessary for review by the attorney, who would provide additional fine-tuning. Thus the tool allows for positive, secure collection of the transitory discovery questions developed during document review and automates the inclusion of these relevant questions into standard materials commonly used.

Applicant's discloses in the specification, paragraph [0054], that the tool selects the particular discovery question and merges them with other form discovery materials. The applicant does not disclose how the tool selects the particular question or how the data is actually merged with other form discover materials. It is not clear what the actually gets incorporated into the materials or what the final product is.

Claim 5 is directed to a tool for recommending a decision in litigation. The Examiner is interpreting this to be a decision regarding litigation. Claim 5 discloses weighting values with each element and an analyzer using the stored information and

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the values to determine a resultant value and a recommendation element using the determined resultant value to an associated decision option to provide a recommended decision.

The specification fails to provide an adequate written description of the invention so that one of skill in the art could practice the claimed invention without undue experimentation.

The applicant discloses:

[0013] These measuring schemes are incorporated into steps that are designed to assist counsel to make a factual assessment, a legal assessment, a staffing assessment, a business assessment, and a budget assessment of the lawsuit. The tool provides a decision tree structure underlying the various steps of the methodology activated by user's answers to yes/no queries to further aid in both the capture and analysis of information.

[0014] Additionally, the tool directs counsel to assign values to reflect the importance of various aspects of the litigation. Based on (1) ***the values that are assigned, (2) counsel's assessment of the particular aspect of the litigation which is captured through the yes/no queries mentioned above, and (3) statistical assessments of likely outcomes*** based on historical records of previously captured information and analogous assessments, the tool provides counsel with suggested paths forward.

[0015] This process will occur on both a step by step basis as well as with an overall assessment of the case. ***Through this multi-step process, counsel, in cooperation with the client, analyze the strengths and weaknesses of the case and determines the appropriate path forward.*** This process is conducted in cooperation with other counsel involved in the case in order to reduce costs and to promote efficiency.

The instant specification discloses assigning values to reflect the importance of various aspects of the litigation and a statistical assessment of likely outcomes base on historical records [0014]. However, the actual values used or how the values are assigned or weighted has not been sufficiently disclosed so that one of skill in the art

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would know what the values are or how to assign them. Applicant has not disclosed what the values are or what they represent. How does one of skill in the art go about weighting values? How does an analyzer determine a resultant value? What is an analyzer? The term analyzer is not defined in the specification. Is it a person or software? The instant specification does not disclose an equation used to determine the resultant values. Without knowing what the values are or how to weight the values, or how the resultant value is determined, one of skill in the art would simply be left to guess what the values are, how to assign them, and how to determine a resultant value.

Applicant's specification further discloses:

[0031] It is, of course, necessary to enter data and that is done by going to a task screen 312 shown in FIG. 5. In the left hand column of the illustrated screen 312 it is noted that there are a series of tasks which need to be performed, including review of the complaint; doing a venue and business analysis, issuing a FOIA request; requesting other agency documentation; doing a locus determination; a court admission evaluation; analysis of the local rules; any legal research necessary; an early evaluation of the discovery; a jury venire; removal analysis, which will be discussed in more detail below; responsive pleading requirements, which is also discussed in more detail below; transfer analysis and early case assessment. Each of these are task and data gathering steps to help develop recommendations. ***The actual data gathered is used in a weighted manner to help determine the recommendation. The actual weighting values are based on assessments of criticality for each particular response as determined by skilled and experienced lawyers in the field.***

[0033] FIGS. 6-10 are screen shots illustrating the venue/business analysis questions. As can be seen, there are a series of questions relevant to determining venue for the particular case and doing a business analysis to see the business factors of the case. ***As to each particular question, an assessment value is provided as shown in FIG. 10.*** For example, particular assessments are such as strongly favors defendant, favors defendant, no effect, favors plaintiff and strongly favors plaintiff. ***These assessments are then weighting values that are entered for each particular question.*** The result of

the assessment and weight value factoring is used to help calculate recommendations provided by the tool. A recommendation could be presented, but is not shown in the exemplary embodiment. Generally, this particular set of questions would be entered by a lawyer, rather than a legal assistant, as generally some experience is required for these particular questions.

[0035] FIGS. 19 through 22 illustrate the exemplary screens used for the removal analysis. For example, there are questions as to whether it was a state or federal court filing, and if it was a state court filing, if there was a basis for removal, what type of jurisdiction and so on. Further, there are a series of decision points that must also be made and these are selected from a list as shown in FIG. 22, which can include strongly favors removal, favors removal, no effect in removal, favors remaining in state and strongly favors remaining in state. ***Again, these particular selections of the decision values are used in a weighting analysis to determine whether to provide the removal recommendation.*** It is further noted that under each particular category of decision is an analysis block so that the user can indicate the particular thought process used to develop the particular indicated decision. This allows review by more experienced parties, associates or more skilled partners for example, without requiring the actual in person presence of the particular user that entered the data.

[0036] ***It is noted on FIG. 21 that a recommendation value is provided. It is understood that the particular data is entered as described above. Each of the data values includes a particular value which is then used in a weighted analysis as derived by an experienced lawyer.*** Using screens not shown, ***experienced lawyers provide weighting factors for each particular data value. The weighting values are then combined to form a score, which is then translated into a recommendation.*** Again, experienced lawyers would select the scores for each particular recommendation. In some embodiments of the tool the data values are compared with prior cases and a correlation is done. This correlation then provides a recommendation, which can be combined with the score-based recommendation or provided separately. In more complicated situations, such as the full case recommendation shown in FIG. 4, the individual recommendations and other data points are matched against a statistical decision tree, providing a recommendation for those cases. The statistical decision tree is developed with prior case results and/or input from experienced lawyers. In other alternatives for both the simpler and more complex situations, various machine learning techniques can be used, with complementary techniques used to provide the recommendations. Examples include supervised feedback learning via an N-dimensional hyperplane classifier, a variation on the ID3 algorithm of Quinlan, self organizing mapping techniques

according to Teuvo Kohonen and other neural network techniques. The particular data collected from the user may vary by the particular techniques used to ensure convergence, but all data would be similar to that illustrated herein.

[0037] **Based on the results of the weighted analysis and review or comparison to similarly situated cases, a recommendation is provided by the tool.** In the illustration of FIG. 21, the recommendation is to Remove. Although not shown in FIG. 21, it would also be appropriate to include the percentage values of data collection and reliability to go with the particular recommendation value to allow a quicker evaluation of the recommendation value.

[0038] FIGS. 23-28 are exemplary screen shots of the responsive pleading task. In this instance, the decision to be made is to answer, dismiss or move for a more definite statement. Within the right-hand side of each of the screen shots are percent complete, reliability and recommendation values. Also shown in FIG. 23 are the determinations necessary to develop the recommendation. A series of questions are provided with entry locations to determine the amount of time and/or dollars necessary to perform the indicated task. These time and/or dollar values are then used to develop an approximate cost for an answer. It is noted that an answer is always accepted by the court and therefore there is no need to do an analysis on the probability of success. FIG. 26, on the other hand, shows a motion to dismiss exemplary screen shot. It is noted on the bottom of the screen there are entry values for the particular times and/of costs for the particular tasks to develop a cost for this alternative. Above that are a series of questions that have drop down or selection boxes to allow the user to select particular answers for each question. **Appropriate values for each particular question are incorporated into the drop down list and are assigned particular numerical values. The numerical values for each of the particular answers is then used in a weighted analysis to determine probability of success,** which is then coupled with the cost to develop a probabilistic value, which is then compared with the cost of an answer and the cost of a motion for more definite statement. The questions and task entries for a more definite statement are shown on FIG. 27. When entries have been made for all of the particular values, a complete recommendation can be made. In addition, as data is entered, the percentage completed and reliability numbers are updated so that not necessarily all data needs to be provided to reach a certain level of confidence in the particular recommendation. In the illustrated example the recommendation is to Answer rather than to move to dismiss or for more definite statement. The weighting and probability values are entered as previously described. For the particular responsive pleading analysis, the data values could be entered by a combination of attorneys and legal assistants.

The applicant has identified an invention which requires a user to input information into a computer wherein many of the values are provided by the subjective analysis of the user, an attorney and/or a client. Because the values are subjective, for a single situation, there could be different results based on the subjective analysis and determination of each user. This subjective information would result in a different value depending on the individual users. Thus, for each individual performing the invention, the result would be different and would have a different meaning. Therefore, the invention does not produce a repeatable or concrete result as required by the statute. The users of the invention must conduct a great deal of experimentation on their part in order to use the invention – to the point that the users become the inventor of their own application of the invention rather than the applicant.

Thus, the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to use the invention since the subjective interpretation does not provide a concrete result which can be used by one in the industry other than the person actually entering the information.

Furthermore, claims 5-12 are also rejected under 35 U.S.C. 112, first paragraph since the claimed invention is not supported by either a specific asserted utility or a well established utility. For the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. The applicant has not defined the numerical score used to assess the values entered. There is no defined meaning as to the value. It is unclear how one skilled in the art would know how the numerical score derived by the invention would be used or what the meaning of the score is to anyone

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other than what it means in the mind of the person actually entering the information. It is unclear how the numerical score value would be used by a person in the industry, i.e., what would the score mean to a person in the industry.

Claim 5 claims a recommendation element using the determined resultant value and the associated decision option provides a recommended decision. What is a recommendation element? It is not defined in the disclosure. How is the recommendation decision made using the determined resultant value and the associated decision options? As set forth above, the specification does not describe how this recommended decision is made in such a way as to enable one skilled in the art to make or use the invention.

Claim 6 states that an analyzer and said recommendation element utilize said collected results to develop a resultant value or recommended decisions. As set forth above, the specification does not describe or provide guidance as to the elements of the step or how to perform this step, i.e., determining the resultant value or recommended decision, in such a way as to enable one skilled in the art to make or use the invention.

Claim 8 states that an assessment is provided. The specification does not describe how the assessment is performed or what goes into the assessment in such a way as to enable one skilled in the art to make or use the invention.

Claims 9-12 identify a statistical decision tree. The specification does not describe how to develop the decision tree in such a way as to enable one skilled in the art to make or use the invention.

As for the statistical decision tree, the specification discloses:

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[0013] These measuring schemes are incorporated into steps that are designed to assist counsel to make a factual assessment, a legal assessment, a staffing assessment, a business assessment, and a budget assessment of the lawsuit. ***The tool provides a decision tree structure underlying the various steps*** of the methodology activated by user's answers to yes/no queries to further aid in both the capture and analysis of information.

[0036] It is noted on FIG. 21 that a recommendation value is provided. It is understood that the particular data is entered as described above. Each of the data values includes a particular value which is then used in a weighted analysis as derived by an experienced lawyer. Using screens not shown, experienced lawyers provide weighting factors for each particular data value. The weighting values are then combined to form a score, which is then translated into a recommendation. Again, experienced lawyers would select the scores for each particular recommendation. In some embodiments of the tool the data values are compared with prior cases and a correlation is done. This correlation then provides a recommendation, which can be combined with the score-based recommendation or provided separately. In more complicated situations, such as the full case recommendation shown in FIG. 4, the individual recommendations and other data points are matched against ***a statistical decision tree, providing a recommendation for those cases. The statistical decision tree is developed with prior case results and/or input from experienced lawyers.*** In other alternatives for both the simpler and more complex situations, various machine learning techniques can be used, with complementary techniques used to provide the recommendations. Examples include supervised feedback learning via an N-dimensional hyperplane classifier, a variation on the ID3 algorithm of Quinlan, self organizing mapping techniques according to Teuvo Kohonen and other neural network techniques. The particular data collected from the user may vary by the particular techniques used to ensure convergence, but all data would be similar to that illustrated herein.

The applicant has not clearly defined the decision tree in the specification. There is no guidance as to how one of skill in the art would go about developing a statistical decision tree or what input goes into the development of the statistical decision tree.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what statutory class the invention falls into. The applicant simply identifies the invention as a tool. However, there is no clear structure identified and there are no clear method steps. For example, claim 1 identifies the invention as comprising an entry field, a menu, storage of discovery related information, form discovery materials, and a discovery production mechanism. A menu and form materials are clearly are not proper structure for an apparatus, but are written data.

Claim 5 is directed to a tool for recommending a decision in litigation comprising interfaces, storage, weighting values, an analyzer, resultant values and a recommendation element. Weighting values appears to be a method step. Resultant values are not structure. Therefore, it is unclear what statutory class the applicant's invention resides in.

Claim 8 is directed to a tool for assessing a litigation comprising a plurality of tools, interfaces, storage, and an assessor. The applicant fails to identify what an assessor is in the specification.

What does the applicant mean by "a tool"?

NOTE: The applicant defines "a tool" in the arguments submitted on June 21, 2006 as something (as an instrument or apparatus) used in performing an operation or necessary in practice of a vocation or profession).

What does the applicant mean by the following language in claim 1 – *an entry field available on a plurality of views not directly related to discovery to request collection of discovery request?*

What does the applicant identify as an analyzer?

Claim 8 identifies the invention as “a tool”. However, the body of the claim language states that there are a plurality of tools according to claim 5. This is unclear.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter. It is not clear what statutory class the applicant's invention would fall into. The applicant identifies the invention as a tool. There does not appear to be sufficient structure identified. For example, in claim 1, the applicant states that the tool comprises an entry field, a menu, form discovery materials and a discovery production mechanism. Thus, the invention is not clearly a machine or system. The applicant does not clearly define method steps although such language as set forth in claim 1 could be construed to be a method step (storage of discovery related information gathered from said menu). Therefore, the invention does not clearly fall into

the statutory class of process or method. It is not an article of manufacture or a composition of matter. Therefore, the invention appears to be non-statutory.

NOTE: In applicant's remarks submitted with the amendment filed on June 21, 2006, applicant states that the claims are properly classified as apparatus or system claims. The applicant states that the present claims are a combination of graphical user interface elements and related data fields, physical storage, stored information, and a generally computer implemented process (page 9). Stored information is not structure. Data fields are not structure.

Claim 5 is directed to a tool comprising interfaces, storage, weighting values, an analyzer, resultant values, and a recommendation element. Weighting values appears to be a method step. Resultant values is not structure or method steps. It is unclear what a recommendation element is or what an analyzer is.

Claim 8 is a tool comprising a plurality of tools, interfaces, storage, and an assessor. Once again, it is unclear what statutory class of the invention would fall into.

Furthermore, it is not clear whether the tool is software or a web site or web pages. Claims drawn to web sites or web pages require careful analysis. It should be determined whether such a claim is drawn to a collection of files or to computer or network hardware.

According to common definitions and barring any "special definition" in an application, web sites or web pages are *files or documents*, not the computer or network hardware that makes available or presents these files. The MPEP gives us guidance on

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how to deal with files or documents at MPEP 2106 IV B 1 (a) and (b), under the headings of "functional descriptive material" and "nonfunctional descriptive material".

If the files or documents are data structures or computer executable code, they are statutory if they are embodied on a computer-readable medium, provided of course they provide a useful, concrete and tangible result. If the files or documents are nonfunctional descriptive material, e.g. music, photographs, compilations of data, such material cannot exhibit any functional interrelationship with the way in which computing processes are performed and would not be statutory. This is true even if the nonfunctional descriptive material is embodied on a computer-readable medium.

Claims 5-12 are rejected under 35 U.S.C. 101 because for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. "Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect

In the present case, the values are subjective. Furthermore, the decision tree identified in claims 9-12 is developed with input from experienced lawyers. Thus, because the values and input are subjective, for a single situation, there could be different results based on the subjective determination of the user. Therefore, the applicant's invention is not capable of providing concrete results as required by 35 U.S.C. 101 since it would be difficult for a person to repeat the analysis and

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determination of another based on the subjective subject matter without undue experimentation.

The Examiner finds that because claim(s) 1-12 are replete with 35 U.S.C. 112 2nd paragraph indefiniteness rejections, it is difficult if not impossible to completely construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of providing art rejections even though the claim(s) contain 35 U.S.C. 112 2nd paragraph rejections, the claims are construed and the art is applied *as much as practically possible*. As noted below, Applicant(s) are invited to contact the Examiner if additional assistance is needed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Newell et al (US 2003/0112270) (hereinafter referred to as Newell).

Referring to Claim 1:

Newell discloses a tool for developing litigation discovery materials, comprising:

an entry field (Figure 1a (103), [0056];

a menu (Figure 3A);

storage ([0024-0029];

forms (Figure 3B-2 Common Case Forms);

production mechanism [0100].

Referring to Claims 2-4:

Newell discloses the menu includes information relating to discovery type and party [0030-0031].

Referring to Claims 5-12:

Newell discloses a tool for aiding in litigation, comprising:

interfaces [Figure 1a (103)] ;

storage [0024-0029];

an analyzer (processor unit 112).

Response to Arguments

Applicant's arguments filed June 21, 2006 have been fully considered but they are not persuasive.

Rejection of claim 1 under 35 USC 112, 1st paragraph.

Applicant directs the Examiner to paragraphs [0009] and [0053-0054]. The Examiner has addressed the arguments along with the cited paragraphs in the rejection above. The applicant states that merging is specifically mentioned as one method of combining discovery related information and form discovery materials. The Examiner asserts that the applicant has failed to disclose how the data is merged.

As for the second rejection, the Examiner directs the applicant to the discussion above with the rejection, wherein the Examiner incorporates paragraphs from the specification in making the rejection.

As for the subjective interpretation set forth in claim 5, the applicant states:

The Office Action is apparently confusing the inputs to the tool used to perform the analysis with the analysis itself. ***The analysis operates on these subjective values provided by the users.*** Contrary to the Office Action, the analysis will always produce the same result when the same values are provided. Clearly, the analysis might produce different results where different values are provided, but that is the purpose of the analysis, to operate on the values provided to it. Most equations will produce different results when different values are provided.

The applicant directs the Examiner to paragraph [0036] which states:

[0036] It is noted on FIG. 21 that a recommendation value is provided. It is understood that the particular data is entered as described above. Each of the data values includes a particular value which is then used in a weighted analysis as derived by an experienced lawyer. Using screens not shown, experienced lawyers provide weighting factors for each particular data value. The weighting values are then combined to form a score, which is then translated into a recommendation. Again, experienced lawyers would select the scores for each particular recommendation. In some embodiments of the tool the data values are compared with prior cases and a correlation is done. This correlation then provides a recommendation, which can be combined with the score-based recommendation or provided separately. In more complicated situations, such as the full case recommendation shown in FIG. 4, the individual recommendations and other data points are matched against a statistical decision tree, providing a recommendation for those cases. The statistical decision tree is developed with prior case results and/or input from experienced lawyers. In other alternatives for both the simpler and more complex situations, various machine learning techniques can be used, with complementary techniques used to provide the recommendations. Examples include supervised feedback learning via an N-dimensional hyperplane classifier, a variation on the ID3 algorithm of Quinlan, self organizing mapping techniques according to Teuvo Kohonen and other neural network techniques. The particular data collected from the user may vary by the particular techniques used to ensure convergence, but all data would be similar to that illustrated herein.

As discussed above in the rejection, the instant specification discloses assigning values to reflect the importance of various aspects of the litigation [0014] and a statistical assessment of likely outcomes base on historical records. However, the

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actual values used or how the values are assigned or weighted has not been sufficiently disclosed so that one of skill in the art would know what the values are or how to assign them. Applicant has not disclosed what the values are or what they represent. How does one of skill in the art go about weighting values? How does an analyzer determine a resultant value? The instant specification does not disclose an equation used to determine the resultant values. Without knowing what the values are or how to weight the values, or how the resultant value is determined, one of skill in the art would simply be left to guess what the values are, how to assign them, and how to determine a resultant value. Furthermore, It is unclear how one skilled in the art would know how the numerical score derived by the invention would be used or what the meaning of the score is to anyone other than what it means in the mind of the person actually entering the information.

As for the fourth rejection, the applicant states ***that the rejection is apparently based on a perception that the numerical score value must be specifically defined.*** The applicant goes on to state that the illustrated embodiments utilize weighted analysis values to form a score, with the score translated to a recommendation and again directs the Examiner to paragraph [0036].

Applicant states that:

The end result of the tool is a recommendation. Any numerical values utilized in the analysis process are internal to the tool itself and are used in the internal calculations and analysis. As such, ***those numerical values need not necessarily have a specific meaning to a person in the industry. It is sufficient that they have a range and that the range is known so that scores can be converted to recommendations.*** Further, the actual numerical values would likely vary based on the specific analysis techniques utilized in any event, so again ***absolute meaning of the specific numeric values is not necessary.***

Once the particular entry value correlations, weighting analysis techniques and so on are defined for a particular embodiment, then a particular numerical value develops meaning, but not until then, and is not required to be defined with respect to the outside environments in any event.

The applicant has not defined any ranges. For the reasons set forth above in the rejection, one skilled in the art clearly would not know how to use the claimed invention. The applicant has not defined the numerical score used to assess the values entered. There is no defined meaning as to the value. It is unclear how one skilled in the art would know how the numerical score derived by the invention would be used or what the meaning of the score is to anyone other than what it means in the mind of the person actually entering the information. It is unclear how the numerical score value would be used by a person in the industry, i.e., what would the score mean to a person in the industry.

Another rejection relates to claim 5 and how a recommended decision is made.

Applicants vigorously traverse this rejection and refers the Examiner to paragraphs [0035-0037]. The Examiner directs the applicant to the discussion above in the rejection. The Examiner asserts that the actual values used or how the values are assigned or weighted has not been sufficiently disclosed so that one of skill in the art would know what the values are or how to assign them. Applicant has not disclosed what the values are or what they represent. How does one of skill in the art go about weighting values? How does an analyzer determine a resultant value? The instant specification does not disclose an equation used to determine the resultant values. Without knowing what the values are or how to weight the values, or how the resultant

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value is determined, one of skill in the art would simply be left to guess what the values are, how to assign them, and how to determine a resultant value.

As for the decision tree, the Examiner asserts that applicant has not clearly defined the decision tree in the specification. There is no guidance as to how one of skill in the art would go about developing a statistical decision tree or what input goes into the development of the statistical decision tree. Applicant argues that the statistical decision tree is mentioned in paragraph [0036]. Applicant further states that ***statistical decision trees and particulars of their development are well known to those skilled in the art and thus are not required to be explained.***

As for the assessment in claim 8, the applicant directs the Examiner to paragraph [0030]. The applicant states that the assessment is the recommendation for the overall litigation, not just a recommendation on one decision or element of the litigation. The applicant states that the actual data gathered is used in a weighted manner to help determine the recommendation. However, as set forth in the rejection, applicant has not identified how the data is used in the weighted manner. The applicant has not defined the assessment and the weight value factoring so that one can calculate a recommendation. The applicant has not defined how the recommendation is calculated.

As for the rejection under 35 USC 101, the Examiner directs the applicant to the discussion above. The Examiner notes the applicant's comment that:

Applicants again note that the Office Action is confusing input data with the operation of the invention. For a given set of input data, the invention will always produce the same result, a useful, concrete and tangible result, for claim 5 a recommendation and for claim 8 an assessment. Different inputs may well produce different results, but such is generally true.

The applicant argues that Newell is not related to recommending a decision in litigation and Newell does not disclose weighted values. Applicant's claim language is directed to a tool for developing litigation discovery material, a tool for recommending a decision and a tool for assessing a litigation. The Examiner asserts that since applicant states that the claimed invention is directed to an apparatus, then the data stored or input into the structure would be non-functional descriptive data, not functionally related to the structure of the invention. A data entry field would be an interface. The data displayed would not be functionally related to the structure. A menu is a display of data. The intended use of the menu is given little patentable weight if the apparatus or system of Newell is capable of having a menu. Storage is storage of data, generally a database. What is stored in the database is non-functional descriptive data. Form discovery materials are not considered to be structure. Weighted values are not considered to be structure.

Thus, the Examiner asserts that as applicant has claimed applicant's invention, Newell applies as prior art and applicant's claim language does not distinguish from the prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

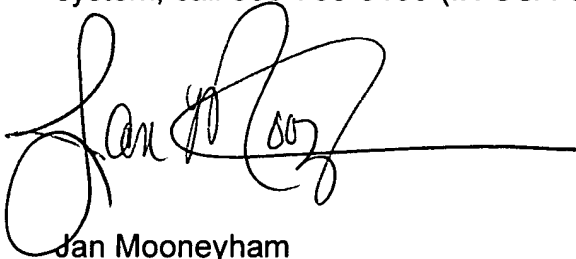
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Jan Mooneyham', with a long horizontal line extending to the right.

Jan Mooneyham
Primary Patent Examiner
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